

**REMARKS**1. Status of the Claims

Claims 1-15 were originally filed. Claims 1, 4, and 13 are amended herein. Claims 1-15 are currently pending. Of the pending claims, claims 7-15 were withdrawn from consideration by the Examiner in the Office Action mailed August 10, 2004 (hereinafter the "Action"). Applicants respectfully traverse the withdrawal of claims 7-15 as discussed below. Reconsideration and re-examination of the present application based upon the amendments above and the remarks below is respectfully requested.

2. Rejections Under 35 U.S.C. § 112, Second Paragraph

Claim 4 is rejected under 35 U.S.C. § 112, second paragraph because the use of the phrase "nucleotide that contains the sequence" allegedly renders the claim vague and indefinite. The Examiner suggests amending claim 4 to insert "sequence" after "nucleotide" in the phrase recited above. Applicants thank the Examiner for this helpful suggestion and request that the present rejection be withdrawn in view of the amendment to claim 4 above according to the Examiner's suggestion.

3. Rejections Under 35 U.S.C. § 101

Claims 1-6 are rejected under 35 U.S.C. § 101 because the claimed invention is allegedly drawn to non-statutory subject matter. The Examiner asserts that the claimed polypeptide could be naturally occurring. The Examiner suggests that the present rejection can be overcome by amending claim 1 to read "An isolated polypeptide...". Applicants thank the Examiner for this helpful suggestion and request that the present rejection be withdrawn in view of the amendment to claim 1 above according to the Examiner's suggestion. Support for the insertion of the term

"isolated" into claim 1 can be found in the specification at page 5, lines 17-20, for example.

#### 4. Claim Objections

The Examiner objects to claims 1-6 because the claims are allegedly drawn to encompass non-elected inventions. The present objection is respectfully traversed.

The Examiner asserts on page 4 of the Action that, "The claims should be amended to only read on the elected invention which is drawn to SEQ ID NO:46". The Examiner further asserts that, "Claims 1-6 (once amended as suggested to overcome the rejections above), only as they are drawn to SEQ ID NO:46, will be allowable" (emphasis in the original).

The present objection neither considers nor rejects claims 1-6 as they were drafted. The courts held that such a position of neither considering nor rejecting the claims is a rejection of the claims (*In re Harnish*, 206 USPQ at 304 (CCPA 1980)). Accordingly, for the purposes of this Response, Applicants are taking the position that claims 1-6 stand rejected under 35 U.S.C. § 121 because the claims are allegedly drawn to encompass non-elected inventions.

However, the Courts have held "that [35 U.S.C.] § 121 could not be used as the basis for rejecting a *single* claim or compelling its replacement by a plurality of narrower claims before examination on the merits would be made" (emphasis in the original. See, *In re Haas* 198 USPQ 334-337 (CCPA 1978) (hereinafter, *In re Haas II*) and *In re Harnish*. Therefore, the Patent Office improperly rejected the present claims under 35 U.S.C. § 121 because 35 U.S.C. § 121 provides no legal authority to impose a rejection on a single claim, even if the claim presents multiple independently patentable inventions. See, *In re*

*Weber*, 198 USPQ 328, 331 (CCPA 1978); *In re Haas*, 179 USPQ 623, 624-625 (CCPA 1973) (hereinafter, *In re Haas I*); and *In re Haas II*. As stated in *In re Weber*:

"The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim - no matter how broad, which means no matter how many independently patentable inventions may fall within it." 198 USPQ 328 at 334.

If the instant rejection is allowed to stand, Applicants will never be accorded "the basic right of the applicant to claim his invention as he chooses". *In re Weber*, 198 USPQ at 331. The Court went on to state that:

"If ... a single claim is required to be divided up and presented in different applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification." 198 USPQ at 331.

Accordingly, Applicants respectfully request that the present rejection of claims 1-6 be withdrawn because the Patent Office does not have a statutory basis for rejecting claims 1-6 under 35 U.S.C. § 121. Furthermore, Applicants respectfully request that withdrawn claims 7 and 8 be rejoined to the Application once claim 1 is held allowable because claims 7 and 8

further define species under generic claim 1 and because the Patent Office does not have a statutory basis for withdrawing claims 7-8 under 35 U.S.C. § 121.

**CONCLUSION**

Claims 1-15 are currently pending in the application. No new matter is added by way of the present Response and Amendment. The amendments to claim 13 is to correct an obvious typographical error. Applicants respectfully requests that the amendments to claims 1, 4, and 13 be entered into the record.

If there are any further fees associated with this response, the Director is authorized to charge our Deposit Account No. 19-0962.

Respectfully submitted,

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Date

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